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In re Application of	:	
HOFMANN et al.	:	DECISION ON
Application No.: 10/564,669	:	
PCT No.: PCT/EP2004/052875	:	PAPERS
Int. Filing Date: 08 November 2004	:	
Priority Date: 20 December 2003	:	UNDER 37 CFR 1.42
Attorney's Docket No.: 3474	:	
For: INSERTION TOOL FOR A MACHINE TOOL	:	

This is a decision on the submission filed by applicants on 13 January 2006, which was accompanied by, *inter alia*, a declaration of the inventors. The indication in the declaration that inventor Markus HECKMANN is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 08 November 2004, applicants filed international application PCT/EP2004/052875 which designated the U.S. and claimed a priority date of 20 December 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 07 July 2005. The thirty-month period for paying the basic national fee in the United States expires at midnight on 20 June 2006.

On 13 January 2006, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee and three declarations of inventors.

On 24 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) according to the application a 35 U.S.C. § 371(c)(1), (c)(2), and (c)(4) date of 13 January 2006 and a 35 U.S.C. 371 date of 13 January 2006.

DISCUSSION

Declaration of Inventors

The declarations of inventors filed 13 January 2006 are not in compliance with 37 CFR 1.497(a)-(b) because they do not list the inventorship set forth in the international application.

37 CFR 1.41(a)(4) states:

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis. See § 1.497(d) and (f) for filing an oath or declaration naming an inventive entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any declaration filed under PCT Rule 4.17(iv) (§ 1.48(f)(1) does not apply to an international application entering the national stage under 35 U.S.C. 371).

The declarations identify two additional inventors (Christof Hoelzl and Johan Huber) compared to the international application. A Form PCT/IB/306 (NOTIFICATION OF THE RECORDING OF A CHANGE) from the International Bureau indicating that an inventor or inventors has been added does not appear in the file. Nor is there any other indication that a PCT Rule 92^{bis} change has been made in the above-identified international application. Accordingly, the inventorship in the national stage is the inventorship set forth in the international application and the declarations filed 13 January 2006 is not sufficient.

Additionally, the declarations filed 13 January 2006 are not sufficient because each contains non-initialed alterations (page 2 of each declaration). 37 CFR 1.52(c). "The Office will not consider whether noninitialed and or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration." MPEP § 605.04(a). Item I.

Further, the declaration of inventors signed by Albrecht Hofmann, Harald Krondorfer, Thomas Schomisch, and Christof Hoelzl is not in compliance with 37 CFR 1.497(a)-(b) because it does not list Markus Heckmann's citizenship in addition to the residence, mailing address and citizenship of the person(s) signing on behalf of the deceased inventor (37 CFR 1.497(b)(2)). (The third page of this declaration is missing.)

Finally, the three declarations of inventors filed 13 January 2006 are not in compliance with 37 CFR 1.497(a)-(b) because none of them are executed by the legal representative.

Because the declarations of inventors filed 13 January 2006 are insufficient, the NOTIFICATION OF ACCEPTANCE mailed 24 April 2006 is hereby VACATED.

Request Under 37 CFR 1.42

The indication in the declaration that Markus HECKMANN is deceased has been treated as a request for status under 37 CFR 1.42.

The declaration does not include the residence, mailing address and citizenship of the person(s) signing on behalf of the deceased inventor (37 CFR 1.497(b)(2)) in addition to the *full name and citizenship of the deceased inventor* (37 CFR 1.497(a)(3)).

CONCLUSION

For the reasons set forth above, the NOTICE OF ACCEPTANCE OF APPLICATION mailed 24 April 2006 is VACATED.

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicants are required to file (1) a declaration in compliance with 37 CFR 1.497(a)-(b) naming the proper inventive entity, or a proper change of inventorship under 37 CFR 1.497(d), or a Form PCT/IB/306 indicating a change effected under PCT Rule 92^{bis} corresponding to the declaration filed 02 October 2006, and (2) a declaration in compliance with 37 CFR 1.497 and 1.42 within TWO (2) MONTHS from the date of mailing of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United States.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

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